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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,579	09/23/2003	Gustav Tappe	07244-00144-US	3905
23416	7590	07/06/2004	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			LE, HOA VAN	
			ART UNIT	PAPER NUMBER

1752

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/668,579

Applicant(s)

TAPPE ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 23 September 2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

This application is a division of application no. 09/865,880 and is before the examiner for consideration on the merits.

I. The record shows that the originally application filed on 25 May 2001 has been amended with the newly added claims 13-39. If a new matter including a broadening of an embodiment in any scope is found, please see the authority stated in *Tronzo v. Biomet Inc.*, 4 USPQ2d 1403.

II. Applicants state that the embodiments in the claims are supported in the Examples of the specification. Therefore, it has been considered and searched to the limited embodiments the in Examples for (1) testing chemical ingredients, (2) about + to – 5% of their testing amounts and (3) testing conditions in all processing steps only. All of these limited embodiments must be considered and included in the instant claims as shown and urged by applicants. Accordingly, an embodiment out side of those in the Examples has not been considered or searched since there is no other chemical ingredients, their amounts and conditions of the processing steps are supported for to the functional, characteristic, conditional, physical or chemical property of the material as disclosed and urged by applicants in supporting for the language “in a mount sufficient to...form storage stable”. Applicants should show or provide a convincing evidence to the contrary for the record. An argument alone may have and be given a little to no value.

III. The amendment filed 23 September 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall

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introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The disclosure of the instant application or (if it becomes a) patent has and is given no value for improperly including no support or new matter or broadening of one or more scope in the amendment with some of them are found in the embodiments in the newly added claims 18, 19, 20 (with respect to the broadening scope of "inorganic acid", 25, 26, 27, 34, 35, 36 (with respect to the broadening scope of "inorganic acid", 37 and 39. Applicants are urged to show or provide a convincing evidence to the contrary. The citations have been fully considered but no proper support is found.

Applicant is required to cancel the new matter in the reply to this Office Action.

IV. Claims 18, 19, 20 (with respect to the broadening scope of "inorganic acid", 25, 26, 27, 34, 35, 36 (with respect to the broadening scope of "inorganic acid", 37 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure of the instant application or (if it becomes a) patent has and is given no value for improperly including no support or new matter or broadening of one or more scope in the amendment with some of them are found in the embodiments in the newly added claims 18, 19, 20 (with respect to the broadening scope of "inorganic acid", 25, 26, 27, 34, 35, 36 (with respect to the broadening scope of "inorganic acid", 37 and 39. Applicants are urged to show or

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provide a convincing evidence to the contrary. The citations have been fully considered but no proper support is found.

V. A. (1) It is allowed to claim by a functional, characteristic, conditional, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, conditional, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. The language “in an amount sufficient to...form a storage stable”, “concentrate having a pH value of between 4 and 9” or the like is considered as the property of a material. It is considered and searched as appeared.

B. In re Schreiber, 44 USPQ2d 1429 states that “A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart...169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart...where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject mater may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.”

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VI. Applicants' prior art submission filed on 23 September 2003 has been considered.

VII. (1) The instant application is added with a new set of claims 13-39.

(2) There are three English language translations of the priority documents on the record in this application. However, applicants fail to provide or show that each and all of the newly added embodiments in the newly added claims 13-39 are all supported in one or more priority documents at page and line for the record.

(3) Accordingly, Papai (6,455,236) is reapplied until all newly added embodiments are shown and found to be supported and resolved.

(4) To overcome the applied Papai (6,455,236), applicants must clearly and precisely point out each and all supports of the newly added embodiments with a precise page and line in a single or multiple priority documents for the record.

VIII. If the applied Papai (6,455,236) is again removed as that in the parent application, it is found that it would be reasonable for Papai to request an interference process to be set up an time during the prosecution of this application or a reexamination if this application becomes a patent because the priority date and the filing a Papai is found to be reasonably close. Furthermore, Papai would have the benefit of showings their reduction to practice date prior to that foreign priority.

IX. (1) A careful studying of the invention in the instant application shows that the claimed amounts of the chemical ingredients in the claimed "concentrate" are also within those in the

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“ready-to-use” compositions known in the art. Please see EP 0 532 042 on page 79 as submitted by applicants. Therefore, patentably different or distinct between “concentrate” and “read-to-use” is not given or considered. It is considered as a matter of selection. Applicants are urged to show or provide an evidence to the contrary. In the absence of convincing evidence, an argument alone would have and be given a little to no value.

(2) The language “concentrate” in the claims has and is given a limited value since at least the main invention of claim 13 contains less than 0.1 mol/l of a bleaching agent and less than 0.5 mol/l of thiosulfate. These amounts are found to be much lower than those in a known or conventional ready-to-use bleach-fixing composition. Evidence can be seen in at least in EP 0 532 042 on page 79 as submitted by applicants.

(3) The claims will be continued to be rejected until the issue of an amount of each of the requisite chemical ingredients is overcome. There are above more than a dozen of references are found. Applicants will have a chance to see how they will be applied a few at a time.

X. The first independent claims 13 has been independently considered and searched. Others are integrally considered and searched.

XI. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meckl et al (3,293,036), Papai (6,455,236) and McGuckin et al (6,096,489).

(1) A careful studying of the invention in the instant application shows that the claimed amounts of the chemical ingredients in the claimed concentrate are also within those in the “ready-to-use” compositions known in the art. Please see EP 0 532 042 on page 79 as submitted

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by applicants. Therefore, patentably different or distinct between "concentrate" and "read-to-use" is not given or considered. It is considered as a matter of selection. Applicants are urged to show or provide an evidence to the contrary. In the absence of convincing evidence, an argument alone would have and be given a little to no value.

(2) The above claims are related to a material. However, the language "suitable for dilution to a working solution" is related to a processing step. It has and given a little to no value in a material claim. It would have and be considered a full value in a process of making a ready-to-use composition claim only.

Merkel et al disclose, teach and suggest a bleach-fixing composition comprising an amount of a bleach agent, an amount of a fixing agent and more than 0.01 mol/l of phosphate and having a pH value from 6.3. Please see Merkel et al at col.1:35-49, 2:58 to 3:2 and 25-35, claims 1 and 3-4. The property language "in an amount sufficient to...form a storage stable" has been considered but is considered as an inherent property. The law requires that applicants must show a convincing evidence to the contrary as clearly pointed out and set forth in paragraph "V" above. For additional conventional or known chemical ingredients in the art, please see Papai (6,455,236) at col.4:48-59 for pH value and phosphoric acid, col.7:9 for ammonium thiosulfate, col.8:18-24 and 45-52 and 63 to col.9:9 and 45-60 for conventional additives as newly cited and admitted by applicants after Papai (6,455,236) was made on the record. Examples 5 and 6 and claims. Please see Remarks on page 7. For a kit, please McGuckin et al (6,096,489) as followed:

"as part  
of a kit that includes one or more other photoprocessing  
compositions, such as  
a bleach-fixing composition, a bleaching composition, a fixing  
composition, or



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a final rinse or a stabilizing composition, or other compositions necessary for color development"

Since the above references are related to bleach-fixing compositions, kits and uses, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cite the known or conventional additives in the art from the secondary references for the desired advantage of obtaining additive benefits as disclosed, taught suggested and obtained in the secondary references. Applicants should show or provide a convincing evidence to the contrary.

XII. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkubo et al (3,591,380), Papai (6,455,236) and McGuckin et al (6,096,489).

(1) A careful studying of the invention in the instant application shows that the claimed amounts of the chemical ingredients in the claimed concentrate are also within those in the "ready-to-use" compositions known in the art. Please see EP 0 532 042 on page 79 as submitted by applicants. Therefore, patentably different or distinct between "concentrate" and "read-to-use" is not given or considered. It is considered as a mater of selection. Applicants are urged to show or provide an evidence to the contrary. In the absence of convincing evidence, an argument alone would has and be given a little to no value.

(2) The above claims are related to a material. However, the language "suitable for dilution to a working solution" is related to a processing step. It has and given a little to no value in a material claim. It would have and be considered a full value in a process of making a ready-to-use composition claim only.

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Ohkubo et al disclose, teach and suggest a bleach-fixable composition comprising up to 50 g/l of a bleach agent, up to 500 g/l of a fixing agent and an amount of phosphate and having a pH value from 4. Please see Ohkubo et al at col.2:54 to 3:12, Example 2. The property language "in an amount sufficient to...form a storage stable" has been considered but is considered as an inherent property. The law requires that applicants must show a convincing evidence to the contrary as clearly pointed out and set forth in paragraph "V" above. For additional conventional or known chemical ingredients in the art, please see Papai (6,455,236) at col.4:48-59 for pH value and phosphoric acid, col.7:9 for ammonium thiosulfate, col.8:18-24 and 45-52 and 63 to col.9:9 and 45-60 for conventional additives as newly cited and admitted by applicants after Papai (6,455,236) was made on the record. Examples 5 and 6 and claims. Please see Remarks on page 7. For a kit, please McGuckin et al (6,096,489) as followed:

"as part  
of a kit that includes one or more other photoprocessing  
compositions, such as  
a bleach-fixing composition, a bleaching composition, a fixing  
composition, or  
a final rinse or a stabilizing composition, or other  
compositions necessary for  
color development"

Since the above references are related to bleach-fixing compositions, kits and use, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cite the known or conventional additives in the art from the secondary references for the desired advantage of obtaining additive benefits as disclosed, taught suggested and obtained in the secondary references. Applicants should show or provide a convincing evidence to the contrary.

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XIII. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schranz et al (3,879,203), Papai (6,455,236) and McGuckin et al (6,096,489).

(1) A careful studying of the invention in the instant application shows that the claimed amounts of the chemical ingredients in the claimed concentrate are also within those in the “ready-to-use” compositions known in the art. Please see EP 0 532 042 on page 79 as submitted by applicants. Therefore, patentably different or distinct between “concentrate” and “read-to-use” is not given or considered. It is considered as a matter of selection. Applicants are urged to show or provide an evidence to the contrary. In the absence of convincing evidence, an argument alone would have and be given a little to no value.

(2) The above claims are related to a material. However, the language “suitable for dilution to a working solution” is related to a processing step. It has and given a little to no value in a material claim. It would have and be considered a full value in a process of making a ready-to-use composition claim only.

Schranz et al disclose, teach and suggest a bleach-fixable composition comprising an amount of a bleach agent, an amount of a fixing agent and an amount of phosphate and having a pH value from 5 . Please see Schranz et al at col.4:11-16 and Example 2. The property language “in an amount sufficient to...form a storage stable” has been considered but is considered as an inherent property. The law requires that applicants must show a convincing evidence to the contrary as clearly pointed out and set forth in paragraph “V” above. For additional conventional or known chemical ingredients in the art, please see Papai (6,455,236) at col.4:48-59 for pH value and phosphoric acid, col.7:9 for ammonium thiosulfate, col.8:18-24 and 45-52 and 63 to col.9:9 and 45-60 for conventional additives as newly cited and admitted by applicants after

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Papai (6,455,236) was made on the record. Examples 5 and 6 and claims. Please see Remarks on page 7. For a kit, please McGuckin et al (6,096,489) as followed:

"as part  
of a kit that includes one or more other photoprocessing  
compositions, such as  
a bleach-fixing composition, a bleaching composition, a fixing  
composition, or  
a final rinse or a stabilizing composition, or other  
compositions necessary for  
color development"

Since the above references are related to bleach-fixing compositions, kits and use, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cite the known or conventional additives in the art from the secondary references for the desired advantage of obtaining additive benefits as disclosed, taught suggested and obtained in the secondary references. Applicants should show or provide a convincing evidence to the contrary.

XIV. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papai (6,455,236) and McGuckin et al (6,096,489).

(1) A careful studying of the invention in the instant application shows that the claimed amounts of the chemical ingredients in the claimed concentrate are also within those in the "ready-to-use" compositions known in the art. Please see EP 0 532 042 on page 79 as submitted by applicants. Therefore, patentably different or distinct between "concentrate" and "read-to-use" is not given or considered. It is considered as a mater of selection. Applicants are urged to show or provide an evidence to the contrary. In the absence of convincing evidence, an argument alone would has and be given a little to no value.

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(2) The above claims are related to a material. However, the language "suitable for dilution to a working solution" is related to a processing step. It has and given a little to no value in a material claim. It would have and be considered a full value in a process of making a ready-to-use composition claim only.

Papai discloses, teaches and suggests a bleach-fixable composition comprising an amount of a bleach agent, an amount of a fixing agent and an amount of phosphate and having a pH value from 5 . Please see Papai at col.3:17-44, 4:23-27 and 47 to 5:7, 6:2-54, 7:9 and 56 to 8:6, 18 to 9:8 and 45-65 and Examples 5 and 6. The property language "in an amount sufficient to...form a storage stable" has been considered but is considered as an inherent property. The law requires that applicants must show a convincing evidence to the contrary as clearly pointed out and set forth in paragraph "V" above. For a kit, please McGuckin et al (6,096,489) as followed:

"as part  
of a kit that includes one or more other photoprocessing  
compositions, such as  
a bleach-fixing composition, a bleaching composition, a fixing  
composition, or  
a final rinse or a stabilizing composition, or other  
compositions necessary for  
color development"

Since the above references are related to bleach-fixing compositions, kits and use, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include or cite the known or conventional additives in the art from the secondary reference for the desired advantage of obtaining additive benefits as disclosed, taught suggested and obtained in the secondary reference. Applicants should show or provide a convincing evidence to the contrary.

XV. It is foreseen that in the event that Papai (6,455,236) being removed again as that in the parent application, another reference will be substituted as that in the parent application.

XVI. Applicants are urged to early come forward with a convincing evidence that there is no close inherent or inherent property as applied on the record to speed up the prosecution and avoid any later work since a claim would have no value if an inherent or closely inherent property is later found, show or provided.

XVII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
25 June 2004

HOA VAN LE  
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.